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This Opinion is Not
Citable as Precedent
of the TTAB

Paper No. 12
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re MW Soft, Inc.

Serial No. 76177458

David L. Hoffman of Law Offices of David L. Hoffman for MW Soft, Inc.

Darryl M. Spruill, Trademark Examining Attorney, Law Office 112 (Janice O'Lear, Managing Attorney).

Before Simms, Cissel and Rogers,
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

MW Soft, Inc. seeks to register SEWERMAP on the Principal Register as a mark for goods identified as "computer program for use by engineers in the design, planning and expansion of sanitary sewer collection systems," in International Class 9.¹ Registration has been

¹ Serial No. 76177458, filed December 4, 2000, based upon applicant's allegation of its bona fide intent to use the mark in commerce. Applicant, in a transmittal letter for a combined filing of its notice of appeal and request for reconsideration, stated that it had also included an amendment to allege use, but the examining attorney, in denying the request for

refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1). The examining attorney's position is that, when used on or in connection with applicant's goods, SEWERMAP will be merely descriptive of them.

When the examining attorney made the refusal final, applicant appealed and filed a request for reconsideration, which the examining attorney denied. The appeal then was resumed and has been fully briefed. Oral argument was not requested.

The USPTO bears the burden of setting forth a prima facie case in support of a descriptiveness refusal. See In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). To establish a prima facie case for refusal, the examining attorney is not required to prove that the public would actually view a proposed mark as descriptive, but must establish a reasonable predicate for the refusal, based on substantial evidence, i.e., more than a scintilla of evidence. In re Pacer Technology, 338 F.3d 1348, 67 USPQ2d 1629 (Fed. Cir. 2003). When the examining attorney sets forth a prima facie case, the applicant cannot simply criticize the absence of additional evidence supporting the

reconsideration, reported that the amendment had not actually been included among the papers filed by applicant.

refusal, but must come forward with evidence supporting its argument for registration. *Gyulay, supra*.

In this case, to meet the USPTO's burden, the examining attorney has made of record article excerpts retrieved from the NEXIS database and various web pages retrieved from the Internet. In addition, in his brief, the examining attorney asks that we take judicial notice of dictionary definitions of "sewer" and "map." Finally, the examining attorney relies on material the applicant submitted about its H₂OMAP software.²

The examining attorney argues that the terms SEWER and MAP each are highly descriptive of applicant's goods and that the combination of the two is just as descriptive because the combination does not create any incongruity or "a unitary mark with a separate, nondistinctive meaning." According to the examining attorney, the specific description conveyed by the combined terms, when considered in conjunction with the goods, rather than in the abstract, is of "the field, features, purpose, and/or subject matter of the goods."

² The examining attorney required the applicant to submit literature detailing the nature of its SEWERMAP software and the applicant, reporting that none existed, submitted the H₂OMAP information because that product, applicant explained, "is a somewhat related computer program."

Applicant essentially acknowledges that both SEWER and MAP, each considered alone, would be descriptive of its computer program for designing, planning and expanding sanitary sewer collection systems. Applicant argues, however, that the combination is not merely descriptive of its product, contending that, "[w]hile it may seem like the composite should have meaning, it really is only two separately descriptive words. It does not make one descriptive word or phrase." Brief, p. 3. Applicant relies on a number of cases in which descriptive terms were combined to make a non-descriptive composite. However, applicant does not attempt to analogize the case at hand to any one of the cases it references and does not explain the basis for its assertion that even if SEWER and MAP are individually descriptive, the combination SEWERMAP is only suggestive.

Applicant also contests the probative value of the evidence made of record by the examining attorney. Specifically, applicant asserts that in the NEXIS excerpts the words SEWER and MAP only appear "nearby" each other and do not appear as either SEWERMAP or SEWER MAP. In addition, the applicant argues that many of the NEXIS excerpts and web pages are or appear to be after the filing date of the application and therefore "are irrelevant."

The question whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services and the possible significance that the term would have to the average purchaser or user of the goods or services. See In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979) and In re Recovery, 196 USPQ 830, 831 (TTAB 1977).

A mark is considered merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes an ingredient, quality, characteristic or feature thereof, or if it directly conveys information regarding the nature, function, purpose or use of the goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-218 (CCPA 1978); see also *Gyulay, supra*. It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. In re Venture Lending Associates, 226 USPQ 285 (TTAB 1985).

It has long been settled that the question whether a term is descriptive or not is determined based on what the

evidence reveals at the time when the issue of registrability is under consideration, i.e., the time when the application is being considered in the USPTO. See In re Thunderbird Products Corporation, 406 F.2d 1389, 160 USPQ 730 (CCPA 1969) ("the board properly considered the literature references published after the filing of the application and correctly decided" term was descriptive and not registrable); see also, In re Samuel Moore & Company, 195 USPQ 237 (TTAB 1977). Accordingly, applicant is incorrect in arguing that much of the evidence proffered by the examining attorney is irrelevant because it postdates applicant's filing date. We have considered all the evidence.

We agree with the applicant that none of the NEXIS excerpts show use of SEWERMAP or even SEWER MAP. But many of the excerpts show that sewer systems are "mapped" and one excerpt (dated, we note, prior to applicant's filing date) refers to the resulting product as a "sewer system map" *Worcester Telegram & Gazette*, August 10, 2000. We cannot conceive of a more apt description, and applicant has not suggested one, for the resulting product when engineers map a sewer system. SEWER MAP, or even SEWERMAP, would be readily perceived as a shorthand reference to a "sewer system map." See *Abcor, supra*, wherein GASBADGE was

held descriptive for the Walden Gas Monitoring Badge used to determine an individual's exposure to pollutants.

We must assess the likely perception of SEWERMAP from the point of view of the average purchaser or user of applicant's computer program, i.e., the engineers engaged in "the design, planning and expansion of sanitary sewer collection systems." Applicant's promotional brochure for its H₂OMAP program, stated by applicant to be similar to its SEWERMAP program, discusses use of "GIS" mapping and modeling functions. Likewise, many of the NEXIS excerpts refer to the GIS system being used in conjunction with mapping of sewers. We have no doubt that municipal engineers working for water and sewer authorities, who would have actual need for working with sewer system maps, and who apparently would be familiar with GIS mapping and modeling, would perceive SEWERMAP to immediately describe the end result of using applicant's computer program.

Frankly, given the existence of terms such as "road map" and "topographic map,"³ we believe that even an average individual would readily perceive SEWERMAP, when used on or in conjunction with applicant's computer program, as

³ We take judicial notice of the presence of entries for both "road map" and "topographic map" in The Random House Dictionary of the English Language (2d ed. 1987).

indicating that the software is for producing sewer system maps. In this regard, we note that the NEXIS excerpts and one of the Internet web pages illustrate discussion of sewer mapping by municipalities in publications of general circulation, not specialized trade publications that only engineers would be exposed to. Nonetheless, the examining attorney need not establish unequivocally that individual members of the general public would find SEWERMAP descriptive. It is sufficient that engineers would find it descriptive.

Applicant has criticized the evidence proffered by the examining attorney, but it has not proffered any evidence of its own to show why engineers would have to cogitate or engage in mental reasoning to determine the meaning of SEWERMAP when used on or in conjunction with applicant's computer program. Nor has applicant articulated any argument why the compound term SEWERMAP would be viewed as incongruous, ambiguous or otherwise distinctive. See In re A La Vieille Russie Inc., 60 USPQ2d 1895, 1899 (TTAB 2001) ("the words 'Russian art' are not lent any additional meaning simply by virtue of their having been combined into the compound term RUSSIANART. Applicant has suggested no such other or additional meaning that results from the compression of the two words into one"). Accordingly, we

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find applicant has not rebutted the prima facie case established by the examining attorney.

Decision: The refusal of registration under Section 2(e)(1) of the Lanham Act is affirmed.